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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,516	11/21/2003	Yiwen Tang	50623.304	3018
7590 07/27/2007				
Victor Repkin Squire, Sanders & Dempsey L.L.P. 1 Maritime Plaza, Suite 300 San Francisco, CA 94111				
			EXAMINER	
			ROGERS, JAMES WILLIAM	
			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			07/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,516

Applicant(s)

TANG ET AL.

Examiner

James W. Rogers, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The amendments to the claims filed 06/18/2007 have been entered, applicants have cancelled claims 9 and 26. Any rejection/objection from the previous office action dated 03/20/2007 not addressed within the office action below has been withdrawn.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8,10-11,15-25,27-28 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by DeSimone et al. (US 2004/0181271 A1), for the reasons expressed in the previous office action dated 03/20/2007.

Claims 1-8,10-25 and 27-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Hossainy et al. (EP 0 970,711 A2), for the reasons expressed in the previous office action dated 03/20/2007.

Claims 1-4,11,16-21,28 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Hossainy et al. (US 2001/0014717 A1), for the reasons expressed in the previous office action dated 03/20/2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hossainy et al. (EP 0 970,711 A2) in view of DeSimone et al. (US 2004/0181271 A1) and/or in view of Hossainy et al. (US 2001/0014717 A1), for the reasons expressed in the previous office action dated 03/20/2007.

Response to Arguments

Applicant's arguments filed 06/18/2007 have been fully considered but they are not persuasive.

Applicants assert that because claim 1 is now amended to include the limitation that the polymeric additive has a degree of crystallinity greater than that of the first polymer, the above references no longer read on the two independent claims 1 and 17.

The relevance of this assertion is unclear. All of the applied references above teach the same coatings comprised of the same polymeric blends as claimed by applicants eg PCL and PHB. The polymers disclosed in those references also either recite or inherently teach the same T_g as claimed by applicants. It is well known in the art that the glass transition temperature T_g and the melting temperature T_m of a polymer is inherently linked to its crystalline structure. See Odian Principles of polymerization pp 24-33. Thus it is the position of the examiner that since the polymers claimed are the same and their T_g values are the same the polymers will inherently have the same

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degree of crystallization as applicants claimed polymer blend because crystallinity and glass transition temperatures are inherently linked. Therefore the new limitation in claims 1 and 17 that the polymeric additive has a degree of crystallinity greater than the first polymer is inherently met, because the same polymer with the same Tg will inherently have the same crystallinity degree. Also applicants own specification at [0035] of the US PGPUB 20050112171 A1 states "the crystallinity of 3-PHB is about 80% while that of PCL is about 57%" thus as evidenced from applicants own specification it would appear that inherently 3-PHB (described as an additive) has a higher degree of crystallinity than PCL (described as a 1st polymer), thus since all of the above references teach blends of PCL and PHB the limitation is inherently met. It appears as though applicants are trying to claim an undisclosed or unknown property of an old polymeric blend. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.

Conclusion

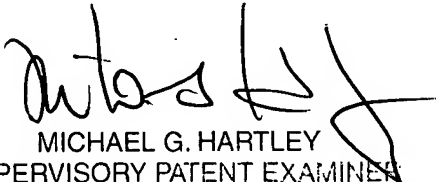
No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 572-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER